

REMARKS

Preliminary Remarks:

Upon entry of this Amendment, claims 1, 2, 4 to 15 and 17 to 19 will be pending of which claims 1 and 12 are independent. Claims 1 and 11 are amended. Support for the claim amendments may be found in the specification as filed. *See, for example*, page 2, lines 33 to 35. Therefore, no new matter is added.

Claim Rejections:

Rejections under 35 U.S.C. § 112

Claim 11 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner stated that it was unclear if the decrease in the water solubility referred to occurred in the food additive, the casing or the binder. As amended, claim 11 clarifies that the water solubility of the food additive and/or binder is decreased by adding the component disclosed in claim 11. Thus, Applicants respectfully submit that, as amended, claim 11 is not indefinite pursuant to 35 U.S.C. § 112, second paragraph and respectfully request withdrawal of this rejection.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 5 to 8, 15, 18, and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Schäfer *et al.* (U.S. Pat. No. 6,200,613). Applicants respectfully traverse.

As amended, claims 1, 2, 5 to 8, 15, 18, and 19 are directed to a food casing which comprises, *inter alia*, two separate and distinct casings, an inner tubular casing and an outer tubular barrier casing, which are bonded to each other only in their respective start region. In contrast, Schäfer *et al.* teach a multilayered food casing wherein the inner layer is connected with the casing by lamination and/or coating to produce a one piece easy-to-handle laminate (column 2, lines 31 to 33). Schäfer *et al.* do not teach a food casing with two separate and distinct casings, *i.e.*, not laminated together. Thus, Applicants respectfully submit that Schäfer do not anticipate claims 1, 2, 5 to 8, 15, 18, and 19 and respectfully request withdrawal of this rejection.

Rejections under 35 U.S.C. § 103

The burden is on the examiner to make a *prima facie* case of obviousness, which requires an objective analysis as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In *KSR International v. Teleflex Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007), the U.S. Supreme Court affirmed that this analysis includes the following factual inquiries:

- (1) determining the scope and content of the prior art;
- (2) ascertaining the differences between the claimed invention and the prior art; and
- (3) resolving the level of ordinary skill in the pertinent art.

Further, the *Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 In View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.* (USPTO Guidelines) state that, having undertaken the factual inquiries of *Graham*, a rejection under 35 U.S.C. § 103 may be supported by one or more of the following rationales:

- (1) combining prior art elements according to known methods to yield predictable results;
- (2) simple substitution of one known element for another to obtain predictable results;
- (3) use of a known technique to improve similar methods in the same way;
- (4) applying a known technique to a known method ready for improvement to yield predictable results;
- (5) choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (6) variations that would have been predictable to one of ordinary skill in the art; and
- (7) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine the prior art reference teachings to arrive at the claimed invention.

72 Fed. Reg. 57526, 57529 (October 10, 2007).

Each of the above-noted rationales requires predictability in the art and/or a reasonable expectation of success, and the Examiner must consider objective evidence that rebuts such predictability and reasonable expectation of success. The objective evidence or secondary considerations may include unexpected results and/or failure of others (*e.g.*, evidence teaching away from the currently claimed invention), evidence of commercial success, and long-felt but unsolved needs, as found in the specification as-filed or other source. *Id.* When considering the

obviousness of a combination of known elements, the operative question is "whether the improvement is more than the predictable use of prior art elements according to their established functions." *KSR*, 550 U.S. at ___, 82 U.S.P.Q.2d at 1396.

Claims 4, 12 to 14, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schäfer *et al.* Applicants respectfully traverse.

As amended, claims 4 and 17 disclose, *inter alia*, a food casing having a separate and distinct outer casing wherein the outer casing has a specified oxygen permeability and water vapor permeability; claims 12 to 14 disclose a shirred tubular food casing. As the Examiner admits, Schäfer *et al.* are silent regarding both the oxygen and water vapor permeability of the barrier casing and the shirring of the sausage casing (Office Action, at page 4). Instead, the Examiner contends that because Schäfer *et al.* recites that the polyamide and polyethylene barrier layers were selected to be steam and gas impermeable, it would have been obvious to one having ordinary skill in the art to have optimized the thickness of the barrier films to achieve whatever level of water and oxygen permeability that was desired for the application for which the casing was to be used. Whatever else, Schäfer *et al.* teach, they do not teach a food casing with two a separate and distinct casings including a water vapor and oxygen permeable outer casing. Instead, as indicated previously, Schäfer *et al.* teach a multilayer food casing in which the layers are laminated together and not a food casing with two separate and distinct casings that are not laminated together.

Further, the Examiner takes official notice that it is universally known in the sausage casing art to shirr sausage casing. However, Applicants respectfully submit that although it may be common in the art to shirr a multilayer casing, in which the layers are laminated together, it is not common in the art to shirr a casing with two separate layers that are not laminated, as claimed in claims 12 to 14. This is because after shirring, a multilayer casing forms a casing "stick", which comprises only one layer. By contrast, the claimed casing, after shirring, still has two separate layers.

In conclusion, Applicants respectfully submit that claims 4, 12 to 14, and 17 are not unpatentable over Schäfer *et al.* and respectfully request withdrawal of this rejection.

Claims 9 to 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schäfer *et al.* in view of Ito *et al.* (EP 0 408 164). Applicants respectfully traverse.

Applicants have discussed the deficiencies of Schäfer *et al.*, *supra*. The Examiner contends that Ito *et al.* teach a water resistant matrix food sheet with a food flavoring material disposed on it, which is dispersed on a binder material. However, whatever Ito *et al.* teach, the combination of Schäfer *et al.* with Ito *et al.* would not result in the food casing with two distinct and separate casings as claimed. The combination of Schäfer *et al.* with Ito *et al.* would result in a one-piece multi-layered casing in which the inner food sheet comprises a food additive and a binder. Neither Schäfer *et al.* nor Ito *et al.* teach or suggest a food casing with two separate and distinct layers. Therefore, Applicants respectfully submit that claims 9 to 11 are not unpatentable over Schäfer *et al.* in view of Ito *et al.* and respectfully request withdrawal of this rejection.

CONCLUSION

In view of the amendments and remarks above, Applicants respectfully submit that this application is in condition for allowance and request favorable action thereon. The Examiner is invited to contact the undersigned if any additional information is required.

As this response is filed within the statutory period for reply, Applicants believe that no fee, other than the appropriate extension of time, is due. If additional fees are required, they may be charged to Deposit Account No. 50-4254, referencing Attorney Docket No. 2901886-000020.

Respectfully submitted,

BAKER, DONELSON, BEARMAN, CALDWELL
& BERKOWITZ, P.C.



Gaujani Prakash, Ph.D.

Registration No.: 53,481

Direct Telephone No.: 202-508-3423

Susan E. Shaw McBee

Registration No. 39,294

Customer No.: **84331**

555 Eleventh Street, N.W.
Sixth Floor
Washington, DC 20004

Telephone: 202-508-3400

Facsimile: 202-508-3402

GP/JRB